

Amendment and Response

Applicant: Daniel J. Fisher

Serial No.: 10/821,068

Filed: April 8, 2004

Docket No.: M120.229.101 / 59692US002

Title: CONVERSION PAD WITH MOISTURE BARRIER

REMARKS

The following remarks are made in response to the Final Office Action mailed December 27, 2005. In that Office Action, the Examiner withdrew newly presented claims 18 and 19 from consideration as being directed to a non-elected invention. Claims 1-17 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 2, 4, 5, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Manor et al., U.S. Patent No. 5,807,161 ("Manor"). Claims 3, 6, 7-12, 14, 15, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Manor. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Manor in view of Chelsey et al., U.S. Patent No. 5,785,784 ("Chelsey"). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Manor in view of Edinger, U.S. Patent No. 6,394,887 ("Edinger").

With this Response, claims 18 and 19 have been cancelled; claims 1, 7, and 13 have been amended; and claims 20-22 have been added. Claims 1-17 and 20-22 remain pending in the application and are presented for consideration and allowance.

35 U.S.C. §112, Second Paragraph, Rejections

Claims 1, 7, and 13 have been amended to address the specific questions raised in the Office Action. It is respectfully requested that the rejections under 35 U.S.C. §112, second paragraph be withdrawn.

35 U.S.C. §§102, 103 Rejections

As amended, claim 1 recites a conversion pad including a supporting layer comprising a backing material and a moisture barrier, with the backing material being flexible. In contrast, the reinforcing plate 17 of Manor (otherwise analogized by the Examiner as being a "backing material") is specifically described as being rigid. *Manor*, col. 8, ll. 49-50. This requisite rigidity is commensurate with the designation in Manor of element 17 being a reinforcing "plate". Further, implementation of a rigid, reinforcing plate with the back-up pad of Manor (as

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compared to the flexible backing material associated with the conversion pad of claim 1) is indicative of a difference between back-up pads of Manor and conversion pads of the pending application. Because back-up pads are directly attached to the sanding tool, a rigid support or interface is desired. Thus, while Manor describes reducing a thickness of the plate 17 to increase overall flexibility of the pad, the plate 17 itself remains comprised of a rigid material. Further, this rigidity inherently dictates that the back-up pad of Manor is not and cannot be a conversion pad, as is otherwise specifically claimed by claim 1. For at least these reasons, then, it is respectfully requested that the rejection of claim 1 as being anticipated by Manor be withdrawn.

Claims 2-6 and 12-16 depend from claim 1, and thus for at least the reasons described above, are allowable over Manor and the rejections thereof should be withdrawn. In addition, with respect to the rejection of claim 12, it is respectfully noted that the Examiner has not provided any evidence in support of the Examiner assertion (in the form of "Official Notice") that materials of claim 12 are the "functional equivalent" of the polyurethane foam body 12 of Manor, nor is a specific factual finding set forth in support of the conclusion as is otherwise required to support a viable obviousness rejection. MPEP §2144.03. Thus, the rejection of claim 12 is further traversed. Similar deficiencies exist with the Official Notice asserted by the Examiner with respect to claim 14; no support is given for the assertion that the injection molded article of Manor is the "functional equivalent" of the claimed coated conversion pad of claim 14.

With respect to the rejection of claim 16, it is respectfully submitted that because the modification of Manor in the manner advanced by the Examiner would defeat the intended purpose of Manor, a requisite suggestion to combine does not exist. In particular, the Manor back-up pad must include the holes 28 to facilitate attachment to the sanding tool. Thus, without the attachment holes 28, the back-up pad of Manor would be unsatisfactory for its intended purpose. As such, there is no suggestion or motivation to make the proposed modification. MPEP §2143.01V. Further, the Examiner's comment that "to have holes or not is a design preference and not a patentable feature" is not supported by substantial evidence, and thus cannot be relied upon in rejecting a claim. MPEP §2144.03. Nothing in the cited reference teaches that holes are a "design preference;" to the contrary, Manor requires the holes 28 in order for the pad

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10 to be useful as a back-up pad. For at least these reasons, then, it is respectfully submitted that claim 16 recites additionally allowable subject matter.

With respect to independent claim 7, it is respectfully submitted that the Office Action's assertion that modifying the rigid plate 17 of Manor to comprise a vulcanized fiber board is obvious because the vulcanized fiber board material would "perform equally well" as the rigid metal, wood, etc., materials specifically recited by Manor is not supported by evidence of record. As such, Applicant respectfully requests that the Examiner explain or provide a reference teaching vulcanized fiber board performing equally as well as the reinforcing plate 17 of Manor as part of a back-up pad. In the absence of such a reference, it is respectfully submitted that amended claim 7 recites allowable subject matter. Claims 8-11 depend from claim 7, and thus for at least these same reasons, are also allowable.

Newly Presented Claims

Newly presented claim 20 depends from claim 1 and recites that the backing material is entirely encapsulated by the moisture barrier. Support for this language is found, for example, at pg. 5, ll. 1-5. In contrast, the reinforcement plate 17 of Manor is exposed via the holes 28, and thus is not encapsulated by the foam body 12. Similarly, the core 37 of Edinger is exposed relative to the material faces 32, 34 at least along a perimeter thereof (as shown in FIG. 3). Thus, it is respectfully submitted that the cited references do not teach or otherwise suggest the limitations of claim 20, such that claim 20 is further allowable.

Newly presented claim 21 recites a conversion pad including a supporting layer having a vulcanized fiber board backing material entirely encapsulated within a polyurethane moisture barrier, along with a heat resistant nylon hot melt adhesive affixing a layer of attachment material to the supporting layer. Support for this language is found, for example, at pg. 5, ll. 1-19. For at least the reasons provided above, it is respectfully submitted that newly presented claim 21 is allowable over the cited references.

Finally, newly presented claim 22 relates to an attachment assembly for attaching an abrasive article to a sanding tool, with the attachment assembly including a back-up pad and a

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conversion pad. Support for this language is found, for example, at pg. 5, ll. 20-22. Because Manor specifically seeks to provide only one pad (and in particular a back-up pad) as part of an abrasive article/sanding tool attachment device, it is respectfully submitted that claim 22 defines over Manor alone or in combination with any other of the cited references.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-17 and 20-22 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-17 and 20-22 are respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 in the amount of \$200.00 to cover the fees as set forth under 37 C.F.R. 1.16(h).

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833 or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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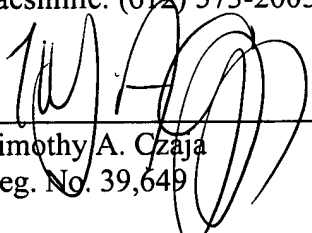
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope, address to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of April, 2006

By: 

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